



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-------------------------|---------------------|------------------|
| 10/633,943 | 08/04/2003 | Gregory Winfield Gorman | 408392 | 5211 |
| 30955 | 7590 | 10/24/2005 | EXAMINER | |
| LATHROP & GAGE LC 4845 PEARL EAST CIRCLE SUITE 300 BOULDER, CO 80301 | | | AHMAD, NASSER | |
| | | ART UNIT | | PAPER NUMBER |
| | | 1772 | | |

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|--------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/633,943 | GORMAN, GREGORY WINFIELD |
| | Examiner | Art Unit |
| | Nasser Ahmad | 1772 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 and 28-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8,11-17,19 and 28-34 is/are rejected.
- 7) Claim(s) 9, 10, 18 and 35 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Finality withdrawn

1. Upon further review of the claimed subject matter and in view of applicant's persuasive request, the finality of the last Office Action, mailed on August 9, 2005 has been withdrawn.

A non-final Action on the merit follows:

Rejection Maintained

2. Claims 1-3, 5,12 and 14 are rejected under 35 USC 102(b) as being anticipated by Wilson for reasons of record in the last Office Action mailed on March 14, 2005.

Response to Arguments

3. Applicant's arguments filed October 7, 2005 have been fully considered but they are not persuasive.

Applicant argues that Wilson does not recite a pavement tape. This is not found to be convincing because Wilson clearly teaches that the tape that is applied to a floor; which includes pavement (as broadly interpreted). Contrary to applicant's argument, Wilson's tape is attached to a vinyl floor covering and the floor covering is located on the floor (which is interpreted to include pavement). As seen in the drawings, Wilson's tape is a continuous elongated flexible tape body, with front and rear surface that do not overlap an end of the tape body.

Applicant also argues that Wilson fails to teach a flexible tape. This is not deemed to be convincing because, as acknowledged by the applicant, the phrase "cardboard is not capable of being bent repeatedly without injury or damage" teaches that the cardboard

can be flexed and hence, is taken to be flexible. Further, the score lines of Wilson would increase its flexibility.

In response to applicant's contention that limitations not explicitly taught by Wilson cannot be used to anticipate the invention as claimed, applicant is informed that it is not required that all limitations be explicitly taught by the applied prior art reference. As shown in Wilson, the tape is directed to its application on a flooring and said flooring would include pavements. Further, applicant should note that the invention claimed is directed to a tape structure and its intended use is directed to a pavement. As such, intended use phrases are not found to be of positive limitations.

Applicant's argument that "Wilson fails to teach the front face as having at least one symbol that conveys commercial information". This is not deemed to be persuasive because Wilson teaches the presence of printed matter which relays communication to the reader. Such communications are synonymous to commerce (Merriam-Webster's Collegiate Thesaurus (1988)) and also "commerce" is defined as exchange of information by Merriam-Webster's Collegiate Dictionary, Tenth Edition. Hence, the information provided by the tape of Wilson is exchanged by the reader and said information is directed to commercial information.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated by the prior art of record discussed above.

Rejections Withdrawn

4. Claims 1-5, 7-8, 11-14, 16-17, 19, 28-32 and 34 rejected under 35 USC 102(e) as being anticipated by Bastiaens has been withdrawn in view of the amendment filed on October 7, 2005.
5. Claims 6, 15 and 33 rejected under 35 USC 103(a) as being unpatentable over Bastiaens has been withdrawn in view of the amendment.

Response to Arguments

6. Applicant's arguments with respect to claims 1-19 and 28-35 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-5, 7-8, 11-14, 16-17, 19, 28-32 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Bastiaens (6514655).

Bastiaens relates to a pavement tape (col. 5, lines 27-28) comprising a continuous (col. 2, line 42) elongated flexible tape body (18) comprising front and rear surface, said front surface comprising at least one symbol (24) that conveys information. As shown in figures 1 and 2, the front and rear surfaces of the tape are exposed at an end.

As shown in figure-2, the rear face comprises an adhesive (36) covered with a release liner (37). The front face is provided with the information print and is covered by a transfer tape (7) that is understood to be releasably bonded to said front face. The symbols include commercial information (col. 5, line 35). The layer (30) is part of the symbol-containing tape and is reflective.

The intended use phrases such as "for conveying information", "configured to be affixed", etc. have not been given any patentable weight because said phrase are directed to an intended use of the claimed product tape.

Regarding claims 11 and 19, the railing is not found to be of positive limitation as it is attached to the intend use pavement and not part of the claimed tape. Hence, it has not been given any patentable weight.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 6, 15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiaens.

Bastiaens, as discussed above, fails to teach that the tape is 6-12 inches wide. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tape to have width of 6-12 inches for having the space to present visible printed information thereon, since it has been held that where the general condition of a claim is disclosed in the prior art, discovering the optimum or workable ranges involve only routine skill in the art. *In re Aller*, 105 USPQ 233. In this case, the prior art tape is also a pavement tape having the structure as claimed.

11. Applicant's arguments filed October 7, 2005 about Bastiaens reference have been fully considered but they are not persuasive.

Regarding Bastiaens reference, applicant argues that the front face does not comprise at least one symbol. This is not found to be convincing the image on the tape of Bastiaens is considered to be a symbol.

As for Bastiaens not mentioning that the front and rear surface are exposed at an end, applicant is informed that the figure 1 and 2 shows that the front and rear surfaces are exposed at an end, and that it is not necessary that all limitations be explicitly recited in the prior art as alleged.

Contrary to applicant's position about claims 4, 13 and 31, the front sheet covering the tape front surface is a transfer tape that is releasably bonded to the pavement tape.

With the tape including layer (30) being reflective, the image would be reflective too when combined with the reflective layer.

As for the claims 11 and 19, the phrase "attachable" only requires the ability to so perform and not a positive limitation as argued.

Regarding the 35 USC 103(a) rejection over Bastiaens, the above explanations apply a *fortiori* herein.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the applied prior art of record discussed above.

Allowable Subject Matter

12. Claims 9-10, 18 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art uncovered so far fails to teach the presence of least one symbol formed as a perforation or a flexible mask tape having at least one symbol formed as a perforation extending from its front face to its rear face, and the tape is bonded to the front face of the pavement tape.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-

Art Unit: 1772

1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad 10/20/05
Primary Examiner
Art Unit 1772

N. Ahmad.
October 20, 2005.